

REMARKS

Claims 25-45 are now pending in the application. Claims 1-24 have been cancelled.

Applicant has thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

Rejections Under 35 U.S.C. § 103

Claims 1, 7-10, 12-14, 19 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Gettemy et al. (US7348964). These rejections are respectfully traversed.

Claims 1-24 have been cancelled. Claims 25-44 are added. Applicant respectfully submits that there is no motivation or reason to combine Kawa and Gettemy to arrive at the present invention.

1. Independent new Claims 25 and 32 of the present application recite a notebook computer with a hidden touch pad, comprising: a display; a main portion connected with the display and including a housing, wherein the housing has a first surface and a second surface, a receiving portion formed in the second surface and not exposed to the first surface, wherein a thickness of the housing that the receiving portion forms therein is thinner than that of the housing that the receiving portion does not form therein and a ratio between a thickness of the housing that the receiving

portion forms therein and a thickness of the housing that the receiving portion does not form therein is 1/3-1/2. See, e.g., Paragraph 32, 33 and Figure 2d.

When evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188- 89, 209 USPQ at 9). Consequently, wherein a thickness of the housing that the receiving portion forms therein is thinner than that of the housing that the receiving portion does not form therein and a ratio between a thickness of the housing that the receiving portion forms therein and a thickness of the housing that the receiving portion does not form therein is 1/3-1/2 must be considered in the obviousness analysis.

The Examiner has stated in the Office Action that Kawa fails to teach wherein a thickness of the housing that the receiving portion forms therein is thinner than that of the housing that the receiving portion does not form therein and a ratio between a thickness of the housing that the receiving portion forms therein and a thickness of the housing that the receiving portion does not form therein is 1/3-1/2. However, the Examiner also says that Gettemy discloses the above feature.

Although examiner recites that "Figure 3 shows the housing 340, where the internal surface is shown to be thinner where the touch-screen 350 is disposed than at other parts of the housing, and the receiving portion is thinner than the rest of the housing making the ratio of the thickness a value between 0 and 1, thus any value of the ratio of the thickness chosen would be "substantially" 1/3~1/2" , however, it is noticed that Gettemy is believed fail to provide an exact ratio of 1/3~1/2. The new

claims 25 and 32 recite that a ratio between a thickness of the housing that the receiving portion forms therein and a thickness of the housing that the receiving portion does not form therein is 1/3-1/2. Moreover, MPEP § 2126 provides:

*PROPORTIONS OF FEATURES IN A DRAWING ARE NOT EVIDENCE OF ACTUAL PROPORTIONS WHEN DRAWINGS ARE NOT TO SCALE
When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See Hockerson-Halberstadt, Inc. v. Avia Group Int'l, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000)*

The disclosure of Gettemy gave no indication that the drawings were drawn to scale. Therefore, the thickness a value between 0 and 1 can not be used as an evidence for rejecting the claimed invention. Accordingly, even a person of ordinary skill in the art were to make the alleged combination, the resulting combination would still not be "a ratio between a thickness of the housing that the receiving portion forms therein and a thickness of the housing that the receiving portion does not form therein is about 1/3-1/2", because both Kawa and Gettemy do not disclose the above features.

On the other hand, the claimed invention has provided a best thickness ratio that is 1/3-1/2 between a thickness of the housing that the receiving portion forms therein and a thickness of the housing that the receiving portion does not form therein to manufacture the housing to make the touch pad 130 that has enhancement sensitivity and is unexposed from the housing simultaneously. With said specific technology feature of housing thickness ration, the touch pad 130 is more sensitive and performance thereof is enhanced. In other words, based on this disclosed "specific thickness ratio" of the housing, not only the housing and the touch pad can specially

coincided to have a smallest volume plus an adequate structure strength of the housing but also reach a well sensitivity of the touch pad, while keep the touch pad unexposed from the housing simultaneously.

Therefore, new independent Claims 26 and 32 are patentable over the cited references and in condition for allowance is respectfully solicited. Further, Applicant respectfully submits that dependent claims 27-31 and 33-38, which ultimately depend from claims 26 and 32 are likewise patentable and in condition for allowance. Withdrawal of the foregoing rejections under 35 U.S.C. § 103(a) is, therefore, respectfully requested.

2. Independent new Claim 39 of the present application recites a notebook computer, comprising: a display; a main portion pivotally connected with the display and allowing the display to pivot between a closed position and an opened position, and including a housing, wherein the housing has a first surface to be adjacent to the display when the display is in the closed position, a second surface formed opposite to the first surface and a first identification portion formed on the second surface; and a touch pad disposed on the first identification portion; wherein a second identification portion is formed on the first surface and corresponding to the first identification portion, thereby to identify the position of the first identification portion and the touch pad.

Discussion of Claim 39 Amendments

New Claim 39 is supported, for example, by Figure 2a, 2d. In figure 2d, the top housing portion 111 includes a first surface 111c (the external surface) and a second surface 111d (the internal, and unexposed surface) on the underside of the first surface

111c. The top housing portion 111 is formed with a receiving portion 111a on the second surface 111d. The touch pad 130 is disposed in the first identification portion 111a. Moreover, to make a better understand for the invention, the applicant change “receiving portion” to “first identification portion”, while further illustrate that “a second identification portion is formed on the first surface and corresponding to the first identification portion, thereby to identify the position of the first identification portion and the touch pad”, supports are found in original present drawings or specification. See eg., in figure 2a and paragraph [0034] in original present specification, which discloses an identification, may be a flange, is formed on the first surface and corresponding to the first identification portion, thereby to identify the position of the first identification portion and the touch pad. Plus, in the art that the invention pertain, a skilled person shall undoubtedly cognize a “receiving portion” as an “identification portion” that facilitate installation of touch pad. Thus, the amendments to the claims do not introduce any new matter. Entry of the amendments is respectfully requested. .

When evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188- 89, 209 USPQ at 9). Consequently, “an identification is formed on the first surface and corresponding to the first identification portion, thereby to identify the position of the first identification portion and the touch pad” must be considered in the obviousness analysis.

According to the paragraph [0023], Kawa teaches that the surface layer of the main part 2 and the surface layer of the trackpad 53 are unified into the surface layer 54

and the trackpad 53 and the controller 45 are attached to the undersurface of the surface layer 54. However, Kawa does not teach that an identification portion, such as a concave receiving portion, should be formed in the undersurface of the surface layer 54. That is, an uniform surface 54 is formed as shown in the figure 3b. The thickness of whole surface 54 is same. Kawa fail to teach a first identification portion for facilitating user cognize where to install the touch pad.

As for the second identification portion in present claim 39, Kawa at most discloses dots formed on a surface for distinguishing, but however fails to disclose or suggest that an identification is formed on the first surface and corresponding to the first identification portion, thereby to identify the position of the first identification portion and the touch pad, since Kawa does not teach that a concave or identification portion is formed to facilitate installing of the touch pad. Accordingly, Kawa does not teach the foregoing features as claimed in new claim 39.

On the other hand, Gettemy teaches uses an outer film 230 that is a single piece of bezel-less transparent flexible thermoplastic to cover the entire top surface of a device. Outer film 230 is flexible in that it has sufficient deflection that a user applying force on the surface of outer film 230 will be able to apply mechanical pressure translated upon display mechanism 250. Pressure sensors 260 beneath display mechanism 250 will be able to register where that position is by measuring the force exerted upon each sensor. See column 5 lines 22-30. In other words, there is no receiving portion in the inside of the outer film 230 to locate the pressure sensors 260. Therefore, the whole outer film has a flat surface. The outer film 230 of the device of Gettemy also is not separated or identified by the second identification portion that

identifies the position of the touch pad. Accordingly, Gettemy does not teach the foregoing features as claimed in new claim 39.

Accordingly, even a person of ordinary skill in the art were to make the alleged combination, the resulting combination would still not include "a second identification portion formed on the first surface and corresponding to the first identification portion, thereby to identify the position of the first identification portion and the touch pad", because both Kawa and Gettemy do not disclose the above features.

Therefore, Applicant respectfully submits that independent Claim 39 is patentable over the cited references and in condition for allowance. Further, Applicant respectfully submits that dependent claims 40-45, which ultimately depend from claim 39, are likewise patentable and in condition for allowance. Withdrawal of the foregoing rejections under 35 U.S.C. § 103(a) is, therefore, respectfully request.

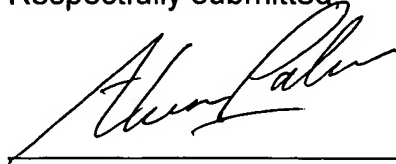
CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested.

Should the Examiner feel that a conference would help to expedite the prosecution of this application, the Examiner is hereby invited to contact the undersigned counsel to arrange for such an interview.

Should any fee be required, the Commissioner is hereby authorized to charge the fee to our Deposit Account No. 18-0002, and advise us accordingly.

Respectfully submitted



January 22, 2010

Date

Alun L. Palmer – Reg. No. 47,838
RABIN & BERDO, PC – Cust. No. 23995
Facsimile: 202-408-0924
Telephone: 202-371-8976